

35 U.S.C. 103 Rejection - Ausubel

The rejection of claims 116-130, 113, and 135-147 under 35 U.S.C. 103 as being unpatentable over Ausubel, U.S. Patent No. 5,905,975 is respectfully traversed.

According to the invention as set forth in claim 116, electronic opening messages are generated from the participants to the intermediary, which represent opening requests to buy and/or to sell amounts of at least one commodity, wherein for at least one commodity, both buy and sell requests are generated by the participants.

To the contrary, in Ausubel the participants (i.e., the user systems 20, 30 and 40; see Fig. 1) all are on the same side of the transaction. Ausubel states at col. 7, ll. 23-27 that the system may be used in auctions where the auctioneer (i.e., auctioneer system 10, see Fig. 1) is a seller, buyer or broker, and the users are buyers, sellers or brokers, and for auction-like activities which cannot be interpreted as buying or selling. In the instance wherein the Ausubel system is used for auctioning commodities, the auctioneer acts either as a seller, or a broker representing an unidentified seller. See col. 10, l. 39- col. 13, l. 5.

While the Examiner correctly observes that without sellers, there could be no buyers, the Examiner has incorrectly interpreted the Ausubel disclosure that "the negotiation process is initiated by a user (seller) indicating that he has an amount of one or more commodities for sale" (Office action at 9) as corresponding to the generation of an electronic opening message as recited in the claims. The announcement by the securities firm that it plans to begin an auction at a certain price (Ausubel col. 10, ll. 42-46) is different from and does not correspond to the commencement of a computerized auction by the auctioneer transmitting a message to each user system (Ausubel col. 11, ll. 5-10). The "securities firm" is not a user of the Ausubel system, but instead is represented by the auctioneer.

In the Ausubel system, an auctioneer generates messages to the users, users generate bid information based on the received messages, and transmit the bid information to a user database. All of the users are on the same side of the transaction, i.e., all of the users are competing with each other to either buy from the auctioneer (where the auctioneer is either the seller or represents the seller) or to sell to the auctioneer (where the auctioneer is either the buyer or represents the buyer).

The auctioneer system then queries the user database, receives answers in response to the queries, and determines if the auction should continue based on the answers received from the user database. If the auctioneer determines that the auction should continue, another message is sent from the auctioneer system to the user systems, and after a predetermined time period the auctioneer again queries the user database. This sequence repeats itself until the auctioneer determines that the auction should not continue. Ausubel contains no suggestion at all that where the auctioneer acts as a broker (i.e., acts on behalf of a seller) that the seller is one of the users on the user systems 20-40.

Contrary to the claimed invention, Ausubel fails to disclose generating electronic opening messages from the participants to the intermediary, wherein the opening messages comprise digital data representing opening requests of the participants to buy and/or to sell amounts of one or more commodities, and wherein, for at least one commodity both buy and sell requests are generated by participants. The outstanding Office action has failed to make out a *prima facie* case of obviousness with respect to this claim limitation, because the Office action has not even alleged that Ausubel discloses the claimed step. Consequently, the rejection based on Ausubel is improper on its face as a matter of law. See In re Sovish, 769 F.2d 738, 226 USPQ 771 (Fed. Cir. 1985) (Obviousness is measured by the claims, not by what is disclosed).

Contrary to the invention set forth in claim 116, Ausubel fails to disclose generating electronic offer messages to the participants from the intermediary in response to received opening messages from the participants, wherein the electronic offer messages represent offers to buy and/or offers to sell amounts of one or more commodities requested by the participants in the opening requests, and wherein for at least one commodity, the offer messages comprise both buy and sell offers. Ausubel discloses that the auctioneer sends a message to the user systems. However, the "message" is a single broadcast message sent to all users that indicates the auctioneer's intent to sell (where the auctioneer is or represents the seller), or to buy (where the auctioneer is or represents the buyer). The message does not contain both buy and sell offers with respect to a single commodity. Further, the message does not represent offers to buy and/or sell amounts of one or more commodities requested by

the participants in response to received opening messages from the participants. Additionally, the single broadcast message does not correspond to electronic offer messages to the participants, with each offer being less than or equal to the amounts represented in the corresponding opening request, as claimed. In the example given by Ausubel, the auctioneer's single broadcast message to all users represents the total amount that is being offered for sale (see col. 11, ll. 6-8). Cf. the present application at page 34, line 27 to page 35, line 4.

The Office action has failed to make out a *prima facie* case of obviousness with respect to this limitation, in that the Office action has failed to even allege that Ausubel discloses the recited step. See Office action at 3. The claims do not simply recite "generating electronic offer messages from the intermediary to the participants to buy and/or sell commodities within the intermediary's objectives" as quoted in the Office action.

Contrary to the claimed invention, Ausubel further fails to disclose the step of generating electronic counter-offer messages, wherein for at least one commodity, the counter-offer messages comprise both buy and sell offers. Again, Ausubel discloses that, based on the answers received from the user database, the auctioneer might send a new "message" (col. 11, ll. 40-45). However, the new "message" again is a single broadcast message sent to all users that indicates the auctioneer's intent to sell (where the auctioneer is or represents the seller), or to buy (where the auctioneer is or represents the buyer). The new message does not contain both buy and sell offers, and does not represent amounts that are less than or equal to the amounts represented in the corresponding opening request. Similarly the responses of users to new auctioneer messages do not comprise both buy and sell requests for the same commodity.

With respect to claim 140, Ausubel fails to disclose a computer-implemented method for representing a participant in an intermediated exchange of commodities with at least one other participant, where the represented participant receives an electronic offer message from the intermediary to respectively sell and/or buy amounts of one or more commodities in response to said electronic opening message and a corresponding electronic opening message from said at least one other participant. In

Ausubel, the exchange of commodities is between the auctioneer and the user (whether the auctioneer acts as buyer/seller or represents an undisclosed buyer/seller). The auction system of Ausubel does not exchange commodities between user systems, as required by claim 140.

35 U.S.C. 103 Rejection - Thiessen

The rejection of claims 131, 132 and 134 under 35 U.S.C. 103 as being unpatentable over Ausubel in view of Thiessen, U.S. Patent No. 5,495,412, also is respectfully traversed. Claims 131, 132 and 134 each include all of the limitations of claim 129. Thiessen discloses an interactive computer-assisted negotiation process, wherein parties are assisted in achieving an optimal, mutually satisfactory agreement in dynamic, multi-party multi-issue negotiations. According to Thiessen, each party inputs into the system information pertaining to their own individual preferences on each issue to be negotiated through an interactive graphical interface. Each party also enters a bargaining range that defines the range of acceptable outcomes for each issue.

Thiessen fails to cure the basic deficiency of Ausubel with respect to claim 129, and consequently no combination of Thiessen with Ausubel could render obvious any of claims 131, 132 or 134, each of which contains all of the limitations of claim 129. Accordingly, the rejection of claims 131, 132 and 134 is improper and should be withdrawn.

Conclusion

In view of the foregoing, claims 116-121, 123 and 125-147 are respectfully submitted to define patentable subject matter, that is neither disclosed nor suggested by Ausubel or Thiessen or any combination of the two. Further and favorable reconsideration of this application and the issuance of a Notice of Allowance are earnestly solicited. In the event that the Examiner remains unpersuaded of the allowability of the claims, he is requested to contact the undersigned to schedule a personal interview in an effort to resolve any remaining issues regarding the differences between the pending claims and the applied prior art.

Please charge any fee or credit any overpayment pursuant to 37 CFR 1.16 or 1.17
to Deposit Account No. 02-2135.

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Attachments: Marked-Up Copies of Amendments

MARKED-UP COPY OF AMENDMENTS SHOWING CHANGES MADE

--116. (Amended) A computer implemented method for an electronic intermediated exchange of a plurality of commodities among a plurality of participants comprising the electronic negotiation steps of:

(a) generating electronic opening messages from the participants to the intermediary, wherein the opening messages comprise digital data representing opening requests of the participants to buy and/or to sell amounts of one or more commodities, and wherein, for at least one commodity [the opening messages comprise] both buy and sell requests are generated by participants;

(b) generating electronic offer messages to the participants from the intermediary in [accordance with objectives of the intermediated exchange] response to received opening messages from said participants, wherein the electronic offer messages comprise digital data representing offers to the participants respectively to buy and/or to sell amounts of one or more commodities requested in said opening messages by said participants respectively to be sold and/or bought, with each offer being less than or equal to the amounts represented in the corresponding opening request, and wherein, for at least one commodity, the offer messages comprise both buy and sell [requests] offers, and wherein, for [each] said at least one commodity, the total of the amounts offered for sale in all the generated offer messages equals the total of the amounts offered for purchase in all the generated offer messages,

(c) generating electronic counter-offer messages from the participants to the intermediary in [accordance with the participants' individual exchange objectives] response to received electronic offer messages, wherein the electronic counter-offer messages comprise digital data representing further requests to buy and/or to sell amounts of one or more commodities with each further request being less than or equal to the amounts represented in the corresponding opening request, [and wherein the counter-offer messages are generated in response to the previous electronic offer messages, and] wherein, for at least one commodity, the counter-offer messages comprise both buy and sell requests; and

(d) repeating steps (b) and (c), if necessary, until the last offer message to each participant is indicated in a further message to the intermediary from that participant to represent offered amounts of one or more commodities to buy and/or to sell in the exchange that are substantially satisfactory according to that participant's individual exchange objectives,

whereby the substantially-satisfactory offered amounts determine an exchange of a plurality of commodities among a plurality of participants.--;

--129. (Amended) A computer implemented method for electronic-intermediated exchange of a plurality of commodities among a plurality of participants comprising the steps of:

(a) receiving from the participants

(i) electronic opening messages, which comprise digital data representing opening requests of the participants to buy and/or to sell amounts of one or more commodities, and

(ii) electronic counter-offer messages, which comprise digital data representing further requests of the participants to buy and/or to sell amounts of one or more commodities, with each further request being less than or equal to the amounts represented in the corresponding opening request, and

(b) generating electronic offer messages to the participants,

wherein the offer messages are generated in response to previously received opening messages and/or to previously received counter-offer messages,

wherein electronic offer messages comprise digital data representing respective offers to the participants to buy and/or to sell amounts of one or more commodities corresponding to respective received requests to sell and/or to buy, with each offer being less than or equal to the amounts represented in the corresponding opening request, and

wherein, for at least one commodity, the opening messages and the offer messages comprise requests to [both] buy and requests to sell, and, for each commodity, the total of the amounts offered for sale in all the generated offer messages

equals the total of the amounts offered for purchase in all the generated offer messages, and

(c) repeating steps (a) and (b), if necessary, until the last offer message to each participant is indicated in a further message from that participant to represent offered amounts of one or more commodities to buy and/or to sell in the exchange that are substantially satisfactory according to that participant's individual exchange objectives [of the participants],

whereby the substantially-satisfactory offered amounts determine an exchange of a plurality of commodities among a plurality of participants.--;

--140. (Amended) A computer implemented method for representing a participant in an intermediated exchange of commodities [among a plurality of] with at least one other participant[s], comprising the steps of:

generating an electronic opening message to an intermediary, wherein the electronic opening message comprises digital data representing an opening request[s] of the participant to buy and/or to sell amounts of one or more commodities; [and]

receiving an electronic offer message from said intermediary to respectively sell and/or buy amounts of one or more commodities in response to said electronic opening message and a corresponding electronic opening message from said at least one other participant; and

generating one or more electronic counter-offer messages to the intermediary in accordance with the participant's individual exchange objectives,

wherein the electronic counter-offer messages comprise digital data representing (i) further requests to buy and/or to sell amounts of one or more commodities with each further request being less than or equal to the amounts represented in the corresponding opening request, or (ii) an indication that the amounts in [the previous] a received offer message are substantially satisfactory to the participant,

wherein each counter-offer message is generated in response to [a previous] an electronic offer message,

wherein an electronic offer message comprises digital data representing offers to the participant to buy and/or to sell amounts of one or more commodities in accordance

with objectives of the intermediated exchange, with the offers being less than or equal to the amounts represented in the corresponding opening request, and whereby the substantially-satisfactory, offered amounts represent[s] each participant's objectives in the intermediated exchange.